

## REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

First, Applicant wishes to thank the Examiner, Bharat Barot, for the helpful telephone interview which was conducted on October 17, 2008 with Marshall J. Brown, attorney for Applicant.<sup>1</sup> During this telephone interview, the parties discussed the finality of the original October 1, 2008 office action. Mr. Barot acknowledged that this office action should have been identified as a non-final office action. A supplemental office action was therefore issued on November 10, 2008, clearly noting that the finality of the October 1, 2008 office action was withdrawn.

In the outstanding office action, the Examiner rejected claim 18 under 35 U.S.C. §101 for, in the Examiner's view, being directed to non-statutory subject matter. In particular, the Examiner asserted that, by reciting "[a] computer program product comprising: computer code..." claim 18 was "non-statutory as not being executable in/by a computer/processor."

In response to this rejection, Applicant respectfully notes that this is the exact same rejection made by the Examiner in the previous April 7, 2008 office action for the present case. In response to this previous rejection, Applicant provided detailed arguments in its July 7, 2008 Amendment and Reply regarding why claim 18 as amended satisfied 35 U.S.C. §101. However, in the most recent office action, the Examiner failed to substantively address any of Applicant's arguments, instead simply reiterating his prior arguments in paragraphs (5) and (16) of the most recent action. For the following reasons, Applicant continues to traverse these rejections.

First, Applicant respectfully submits that one of ordinary skill in the art would readily understand that a computer program product that is embodied on a storage medium is clearly "executable" by a processor. If such were not true, every computer program product stored

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<sup>1</sup> In the Examiner's Interview Summary, Peter Albert Jr. was listed as a participant in the interview. However, Applicant notes for the record that Mr. Brown was the only Applicant representative participating in this interview.

in a memory would have no value and never be able to provide the program's intended purpose.

Furthermore, Applicant respectfully submits that the disclosure clearly provides a basis for one ordinary skill in the art to understand that the computer program product of the present application is executable by a processor. For example, Figure 4 of the disclosure clearly depicts that the device includes a CPU coupled to a memory. One of ordinary skill in the art would understand that such a configuration enables the CPU to execute program products embodied on the memory. As such, Applicant submits that the Examiner's assertion that the claim is directed to non-statutory subject matter is improper and therefore should be withdrawn.

In addition to the above, Applicant respectfully submits that both the United States Court of Appeals for the Federal Circuit and the Manual of Patent Examining Procedure (MPEP) are clear that a computer program product embodied on a computer-readable medium satisfies the requirements of 35 U.S.C. §101. In *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994), the Federal Circuit clearly noted that such an arrangement is statutory, noting:

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory.

The guidelines provided in the Manual of Patent Examining Procedure (MPEP) for determining whether computer-related subject matter meets the requirements of 35 U.S.C. § 101 for statutory subject matter are described in MPEP §2106.01 are similarly clear, noting that:

"[F]unctional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component...When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of

technology permits the function of the descriptive material to be realized.

In other words, both the United States Court of Appeals for the Federal Circuit and the MPEP are clear in their distinction between stand-alone computer programs, which may not meet the statutory requirements, and programs recited in conjunction with a memory or similar storage medium, which do meet the requirements. Since a computer program product embodied on a computer-readable medium meets the above standard, Applicant submits that the present claim language is statutory.

In response to Applicant's prior arguments concerning the statutory nature of claim 18, the Examiner simply repeated his earlier arguments in the "Response to Arguments" Section of the most recent office action, stating:

In response to applicant's argument towards 101 rejection that the claimed invention of the claim 18 is directed to non-statutory subject matter because claim 18 recited "A computer program product comprising: computer code...", which is non-statutory as not being executable in/by a computer/processor.

The above arguments, however, fail to address any of the arguments previously proffered by Applicant, and these arguments also fail to take into account the language "embodied in a computer-readable medium" previously added to claim 18. For this reason, Applicant respectfully requests that the Examiner consider Applicant's in detail and, if he feels that Applicant's arguments are not persuasive, provide detailed reasoning why MPEP §2106.01 and the Federal Circuit's decision in *In re Lowry* are inapplicable to the issues at hand. With such an explanation, the Examiner's rejection of claim 18 under 35 U.S.C. §101 cannot stand.

The Examiner also rejected claims 1-21 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,879,979 (Hindawi) in view of U.S. Patent No. 7,135,259 (Bakke). In particular, in rejecting independent claims 1, 7, 14 and 18, the Examiner asserted that Hindawi taught all of the features of these claims except for certain features relating to flag functionality. However, the Examiner asserted that these features could be found in

Bakke, and that it would it have been obvious to combine these features with Hindawi. For the following reasons, Applicant disagrees with this position.

As was discussed at length in Applicant's January 7, 2008 Amendment and Reply, Applicant respectfully submits that, contrary to the Examiner's assertions, Hindawi fails to teach or suggest "receiving a provisioning content document from a wireless communication network, the provisioning content document comprising configuration information for a device," instead teaching entirely different features. For example, various sections of Hindawi state:

An information requestor is an organization or individual which requests configuration information of the target computer by sending query documents and receives responses.... The information provider is an organization or individual which receives query documents from the requestor and provides response documents to the requestor. (Column 5, line 60 -column 6, line 1; emphasis added).

The public server 104 run by the support organization is responsible for serving the query documents to the client application 107, receiving response documents from the client application 107, and serving the response documents to the private server 105. (Column 6, lines 61-65; emphasis added).

The client application 107 running on the customer PC 101 is responsible for retrieving query documents from the public server 104, inspecting the customer PC 101 to obtain configuration information and constructing response documents, and sending the response documents to the public server 104. (Column 6, line 66 - column 7, line 4; emphasis added).

As emphasized above, Hindawi teaches two types of messages. The first type is a query message, which is sent from the network device to the client device. The second type is a response message, which is sent from the client device to the network device. As discussed in more detail below, both type of messages fail to read upon the limitation "receiving a provisioning content document from a wireless communication network, the provisioning content document comprising configuration information for a device" as required by the independent claim 1 and other independent claims.

In the case of the query message discussed above, Applicant submits that the query message cannot read on the claims because the query message does not carry “configuration information,” as recited in claims 1, 7, 14 and 18. (emphasis added). Instead, the query message of Hindawi only comprises “questions” relating to the client device. As is clearly shown in Figure 2 (reproduced below), the query message consists of questions written in “simplified English.” (Column 4, line 35).

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*** The time that this document was processed ***
Q: now

*** Bios data ***
Q: version of bios
Q: date of bios

*** System and processor information ***
Q: vendor name of main processor
Q: system language
Q: speed of main processor
Q: number of processors

*** Operating system information ***
Q: name of operating system
Q: release of operating system
Q: major version of operating system
Q: minor version of operating system

Q: key "Manufacturer" of section "General" of file
"oeminfo.ini" of the system folder

Q: names of applications whose (value "CompanyName" of

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As represented in Figure 2 above, the items in the query message of Hindawi comprise questions such as “date of bios,” “name of operating system,” “number of processors,” and “speed of main processor.” These are simple inquiries that do not include any configuration information. These questions are asked in order to determine “presence of certain hardware, software, files, registry, entries, and configuration settings.” (Column 7, lines 26-28). Therefore, since the network device is asking about configuration settings, the network device cannot be delivering configuration settings (since it does not have them yet). In other words, the query message cannot be delivering the same information that it is asking

about. As such, the query messages of Hindawi cannot constitute the provisioning content document or other information “comprising configuration information for a device” required by the independent claims.

With regard to the “response messages” of Hindawi, although these messages could possibly carry configuration information, the response messages are simply going in the wrong direction to satisfy the relevant limitations of the independent claims. For example, column 6, lines 63-64 of Hindawi specifically teaches “receiving response documents from the client application.” (emphasis added). In contrast, Claim 1 recites “receiving a provisioning content document from a wireless communication network.” (emphasis added). Therefore, since the response message of Hindawi is being sent from the client to the network (instead of from the network to the client), the response message of Hindawi is traveling in the wrong direction and therefore cannot read on the limitation “receiving a provisioning content document from a wireless communication network, the provisioning content document comprising configuration information for a device” or the similar limitations found in the other independent claims.

With regard to Bakke, although the Examiner has asserted that this reference teaches various limitations regarding the use of a flag parameter, the Examiner has failed to point to any portion of Bakke that is capable of curing the deficiencies discussed above with regard to Hindawi. In particular, because the Examiner has failed to point to any portion of Bakke that teaches or suggests “receiving a provisioning content document from a wireless communication network, the provisioning content document comprising configuration information for a device” or similar limitations found in the other pending independent claims, Applicant respectfully submits that the combination of Hindawi and Bakke suggested by the Examiner fails to teach all of the claim limitations found in independent claims 1, 7, 14 and 18.

For all of the above reasons, Applicant submits that independent claims 1, 7, 14 and 18 and their respective dependent claims are allowable over the combination of Hindawi and Bakke.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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